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1                   20. The method of claim 18 wherein the client machine comprises  
2 a Java-capable web browser, the output device comprises a JetSend capable  
3 device, and the server comprises a Java vending machine.

#### **REMARKS/ARGUMENT**

In the Office Action, the Examiner noted that claims 1-20 are pending in the application and that claims 1-20 are rejected. By this argumentative response, claims 1-20 remain pending in this application.

#### **Rejections Under 35 U.S.C. §112, first paragraph**

Claims 8 and 19 are rejected under 35 U.S.C. §112, second paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

More particularly, the Examiner has stated that the Examiner was not able to find support within the instant application for the following excerpts as recited within instant claims 8 and 19, and labeled as a) and b), respectively:

- a) "the cookie containing specific information detailing a user form to be printed"
- b) "storing ... the form temporarily within a cookie of the client machine".

The Examiner is referred to page 7, lines 8-9 of the application, which recites, in part:

"A 'cookie' is a small piece of information which a web server can store temporarily with a web browser"

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Furthermore, the Applicant asserts that the term "cookie" is a widely recognized term within the relevant arts, and that further description is not required by those having ordinary skill therein.

Applicant asserts that complete support for both excerpts a) and b) above may be found at least on page 10, line 1, to page 11, line 20, of the instant application.

Hence, Applicant asserts that claims 8 and 19 overcome the §112, first paragraph, rejection, and withdrawal of the rejection is respectfully requested.

#### **Rejections Under 35 U.S.C. §102**

Claims 1-2, 4-5, 11-14, and 17-18 are rejected under 35 U.S.C. §102(e) as being anticipated by *Laursen, et al.* (U.S. Patent 6,065,120). Applicant respectfully traverses this rejection.

The Examiner is referred to MPEP §2131, which recites, in part:

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Stated another way, in order to establish a *prima facie* case of anticipation under 35 U.S.C. §102, the Examiner must provide: 1) A single reference, 2) that teaches or enables, 3) each of the claimed elements (arranged as in the claim), 4) expressly or inherently, 5) as interpreted by one skilled in the art.

Therefore, if the Applicant can identify even a single element recited in each of the rejected claims that is not provided in the reference, the §102(e) rejection of claims 1-2, 4-5, 11-14, and 17-18 must be withdrawn.

Claim 1 recites a forms printing apparatus comprising a web server having a forms solution for supporting forms generation and transmission via an

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information exchange protocol and a control interface for generating and transmitting forms as electronic material, a request initiating a client machine having a web browser and a network connection with the web server, and an output device selected by a user and supporting an information exchange protocol and a control interface for receiving forms transmitted from the web server and rendering user-perceptible forms.

The reference to *Laurson, et al.* fails to provide a forms printing apparatus of any kind, and in particular fails to provide a forms printing apparatus having the features as recited in instant claim 1. As a matter of fact, the reference to *Laurson, et al.* is completely devoid of the words "printing", "printer", "forms", or their equivalents. Applicants request that the Examiner specifically point out where such features are shown anywhere within U.S. Patent No. 6,065,120.

Claim 11 recites a forms storage, retrieval and printing system comprising a server including a memory, a database defined in the memory, a forms solution for supporting forms generation and transmission, and a control interface for generating and transmitting forms as electronic material across a network interconnected with the server, a request initiating client machine having a browser and a network connection, an output device selected by a user and supporting an information exchange protocol and a control interface for receiving forms transmitted from the web server and rendering user-perceptible forms.

The reference to *Laurson, et al.* fails to provide a forms storage, retrieval and printing system of any kind, and in particular fails to provide a forms storage, retrieval and printing system having the features as recited in instant claim 11. Applicants request that the Examiner specifically point out where such features are shown anywhere within U.S. Patent No. 6,065,120.

Claim 18 recites a method for selecting and printing forms remote from a user, comprising accessing a web-capable server with a web-accessible client machine, selecting a form to be printed from a selection of forms stored

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on the server, selecting a web address of an output device for printing the selected form having an information exchange protocol and a control interface for receiving forms transmitted from the web server and rendering user-perceptible forms, and printing the rendered form at the output device.

The reference to *Laurson, et al.* fails to provide a method for selecting and printing forms remote from a user including selecting a form to be printed from a selection of forms stored on the server, and printing the rendered form at the output device, as recited in combination with the other features of instant claim 18.

Accordingly, Applicant asserts that the Examiner has not established *prima facie* anticipation of claims 1, 11 and 18. Claims 2, 4-5, 12-14, and 17 respectively depend from claims 1 and 11, and therefore *prima facie* anticipation of claims 2, 4-5, 12-14, and 17 has not been demonstrated by virtue of dependency.

Withdrawal of the §102(e) rejection of claims 1-2, 4-5, 11-14, and 17-18 is respectfully requested.

#### **Rejections Under 35 U.S.C., §103**

Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Laurson, et al.*, in view of *Covert, et al.* (U.S. Patent 6,334,117 B1). Applicant respectfully traverses this rejection.

In order to establish a *prima facie* case of obviousness, the Examiner must provide: 1) one or more references, 2) that were available to the inventor and, 3) that teach, 4) a suggestion to combine or modify the reference(s), 5) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

The Examiner has admitted that *Laurson, et al.* fails to teach or suggest a Java vending machine operative to pull a user selected JetSend job (page 4 of the Office Action).

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The reference to *Covert, et al.* fails to cure this deficiency, as *Covert, et al.* fails to teach or suggest a Java vending machine operative to pull a user selected Jetsend job.

The reference to *Covert, et al.* is directed to an automated banking machine and system operative to conduct [financial] transactions (Abstract of *Covert, et al.*), and provides no mention of Jetsend in any context.

There is no teaching or suggestion to be found in either of the references to *Laursen, et al.* or to *Covert, et al.* that would facilitate the extraction of elements from these respective references and to somehow combine them to result in the invention as recited in instant claim 7. The respective references to *Laursen, et al.* and to *Covert, et al.* - alone, or in any combination - are deficient to teach or suggest a Java vending machine operative to pull a user selected Jetsend job, as recited in combination with the other features of instant claim 7.

Therefore, the 35 U.S.C. §103(a) rejection of claim 7 is in error and should be withdrawn.

Claims 8 and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Laursen, et al.*, in view of *Covert, et al.*, as applied to claim 7, and further in view of *Laor* (U.S. Patent 6,041,309). The rejection is in error.

As claim 8 depends on claim 7, claim 8 includes all of the features of claim 7 in combination with its own distinctive features.

The reference to *Laor* fails to cure the deficiencies previously discussed regarding the respective references to *Laursen, et al.* and *Covert, et al.*, as the reference to *Laor* fails to teach or suggest a Java vending machine operative to pull a user selected Jetsend job, as recited in combination with the other features of instant claim 8 by virtue of dependancy on instant claim 7.

Therefore, the 35 U.S.C. §103(a) rejection of claim 8 is in error and should be withdrawn.

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As claim 19 depends from claim 18, claim 19 includes all of the features of claim 18 in combination with its own distinctive features.

The reference to *Laursen, et al.* fails to teach or suggest selecting a form to be printed from a selection of forms stored on a server, and selecting a web address of an output device for printing the selected form, in combination with the other features recited in instant claim 18.

The reference to *Covert, et al.* fails to cure the deficiency of *Laursen, et al.*, as *Covert, et al.* fails to teach or suggest selecting a form to be printed from a selection of forms stored on a server, and selecting a web address of an output device for printing the selected form, in combination with the other features recited in instant claim 18.

Furthermore, the reference to *Laor* fails to cure the deficiency of *Laursen, et al.*, or *Covert, et al.*, as *Laor* fails to teach or suggest selecting a form to be printed from a selection of forms stored on a server, and selecting a web address of an output device for printing the selected form, in combination with the other features recited in instant claim 18.

There is no combination of elements that can be taken from the respective references to *Laursen, et al.*, *Covert, et al.*, and *Laor* that can result in the invention as recited by instant claim 19, as none of these references teaches or suggests selecting a form to be printed from a selection of forms stored on a server, and selecting a web address of an output device for printing the selected form, in combination with the other features recited in instant claim 19.

Therefore, the 35 U.S.C. §103(a) rejection of claim 19 is in error and should be withdrawn.

Claim 3 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Laursen, et al.*, in view of *Wright* (U.S. Patent 5,704,029). Applicant respectfully traverses this rejection.

As claim 3 depends from claim 1, claim 3 includes all of the features of claim 1 in combination with its own distinctive features.

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The reference to *Laursen, et al.* does not teach or suggest any kind of forms printing apparatus, as argued above in support of instant claim 1.

The reference to *Wright* fails to cure the deficiency of *Laursen, et al.*, as the reference to *Wright* fails to teach or suggest any kind of forms printing apparatus. In fact, *Wright* teaches directly away from printed forms, as *Wright* states that:

"The present invention utilizes electronic forms to gather information. Electronic forms are easier to complete and can be validated as they are being completed. Paper forms do not have to be printed and stored. Revisions are easily made to an electronic form, thus eliminating the cost associated with a new printing of a paper form." (Introduction of *Wright*).

The Examiner is referred to MPEP §2141.02, which recites, in part:

"Prior art must be considered in its entirety, including disclosures that teach away from the claims.... A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)

Because the reference to *Wright* is directed exclusively to the use of electronic forms and expressly teaches away from printed forms, *Wright* fails to teach or suggest a forms printing apparatus of any kind.

Furthermore, there is no combination of elements that can be selected from the reference to *Laursen, et al.* and then somehow combined with other elements selected from *Wright* to result in a forms printing apparatus as recited in instant claim 3.

Therefore, the 35 U.S.C. §103(a) rejection of claim 3 is in error and should be withdrawn.

Claims 6, 9-10, 15-16, and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Laursen, et al.*, in view of "HP JetSend Technology:

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Making Device-to-Device Communication Simple (hereinafter "*Jetsend*"), <http://web.archive.org/web/1998012423300/www.jetsend.com/Backgrnder.html> (pp. 1-6, 1/24/98). Applicant respectfully traverses this rejection.

As claims 6 and 9-10 depend from claim 1, claims 6 and 9-10 respectively include all of the features of claim 1 in combination with their own respective features.

As stated above, the *Laurson, et al.* reference fails to provide a forms printing apparatus of any kind, and in particular fails to provide a forms printing apparatus having the features as recited in instant claim 1. The reference to *Laurson et al.* fails to teach or suggest "forms", "forms generation", "forms transmission", or "printing", or their equivalents, in any context.

The *Jetsend* reference fails to cure the deficiencies of *Laurson, et al.*, as the *Jetsend* reference fails to teach or suggest a forms printing apparatus comprising a web server having a forms solution for supporting forms generation and transmission via an information exchange protocol and a control interface for generating and transmitting forms as electronic material, a request initiating client machine having a web browser and a network connection with the web server, and an output device selected by a user and supporting an information exchange protocol and a control interface for receiving forms transmitted from the web server and rendering user-perceptible forms, as positively recited in instant claim 1.

There is no way to select elements from *Laurson, et al.* and then somehow combine those elements with other elements selected from *Jetsend* to result in the invention as recited in any of claims 6, 9 or 10 of the instant application. All of the required elements and their respective arrangements are simply missing from any combination of the *Laurson, et al.* and *Jetsend* references.

Therefore, the 35 U.S.C. §103(a) rejection of claims 6 and 9-10 is in error and should be withdrawn.

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Claim 15 depends from claim 11 and therefore includes all of the features of claim 11, in combination with its own distinctive features. Further, claim 16 depends from claim 15, and therefore includes all of the features of claims 11 and 15, in combination with its own distinctive features.

The *Laursen, et al.* reference fails to provide a forms storage, retrieval and printing system comprising a server including a memory, a database defined in the memory, a forms solution for supporting forms generation and transmission, and a control interface for generating and transmitting forms as electronic material across a network interconnected with the server, a request initiating client machine having a browser and a network connection, an output device selected by a user and supporting an information exchange protocol and a control interface for receiving forms transmitted from the web server and rendering user-perceptible forms, as positively recited in instant claim 11.

The *Jetsend* reference fails to teach or suggest a forms storage, retrieval and printing system, as the *Jetsend* reference is directed to a protocol for the negotiation and exchange of information between Jetsend-capable devices. The *Jetsend* reference does not teach or suggest a specific system having the features as recited in instant claim 11.

There is no teaching or suggestion within either the *Laursen, et al.* or the *Jetsend* references to select elements from either of those references and then somehow combine those elements to result in the invention of claim 11 of the instant application, as all of the necessary elements are not provided.

Therefore, *prima facie* obviousness of claims 15 and 16 has not been demonstrated, and the 35 U.S.C. §103(a) rejection of claims 15 and 16 should be withdrawn.

Claim 20 recites the method of claim 18 wherein the client machine comprises a Java-capable web browser, the output device comprises a Jetsend capable device, and the server comprises a Java vending machine. Therefore, claim 20 includes all of the features of claim 18 in combination with its own distinctive features.

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The *Laurson, et al.* reference fails to teach or suggest a method for selecting and printing forms remote from a user including selecting a form to be printed from a selection of forms stored on the server, and printing the rendered form at the output device, as recited in combination with the other features of instant claim 18.

The *Jetsend* reference fails to cure the deficiency of *Laurson et al.*, as the *Jetsend* reference fails to teach or suggest a method for selecting and printing forms remote from a user including selecting a form to be printed from a selection of forms stored on the server, and printing the rendered form at the output device.

Furthermore, neither the *Laurson, et al.* nor the *Jetsend* references teach or suggest a server comprising a Java vending machine, as recited in combination with the other features of instant claim 20.

There is no way that all of the elements and their respective combination can be provided by any combination of elements from the *Laurson, et al.* and *Jetsend* references to result in the invention as recited in instant claim 20.

Therefore, the 35 U.S.C. §103(a) rejection of claim 20 is *prima facie* defective and should be withdrawn.

For these reasons at least, withdrawal of the rejections of claims 1-20 and reconsideration in favor of allowance is requested.

#### **CONCLUSION**

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be

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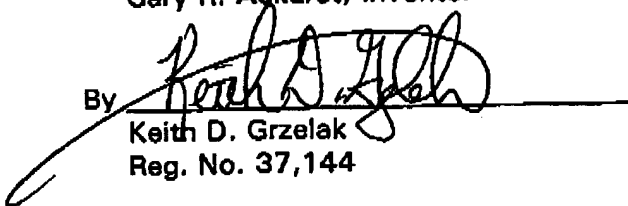
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anything other than a Notice of Allowance, the undersigned respectfully  
requests a telephone interview before issuance of any such subsequent action.

Respectfully submitted,

Gary R. Ackaret, Inventor

By

  
Keith D. Grzelak  
Reg. No. 37,144

June 13, 2002  
(509) 624-4276

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**PATENT APPLICATION  
DOCKET NO. 10980623-1****IN THE  
UNITED STATES PATENT AND TRADEMARK OFFICE****INVENTOR(S):** Gary R. Ackaret**SERIAL NO.:** 09/310,073**GROUP ART UNIT:** 2176**FILED:** May 10, 1999**EXAMINER:** Cesar B. Paula**SUBJECT:** "Abstract of a Web Based Forms Printing Solution"**VERSION WITH MARKINGS TO SHOW CHANGES MADE  
IN RESPONSE TO OFFICE ACTION DATED MARCH 13, 2002****In the Claims:**

No claims have been amended, cancelled, or added herein.

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